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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,951	01/15/2002	William Kress Bodin	AUS920010850US1	4423

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IBM CORP (BLF)
c/o BIGGERS & OHANIAN, LLP
504 LAVACA STREET, SUITE 970
AUSTIN, TX 78701-2856

EXAMINER

FLEARY, CAROLYN FATIMAH

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/046,951	Applicant(s) BODIN ET AL.	
	Examiner Carolyn F. Fleary	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 12-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/19/2002</u> . | 6) <input checked="" type="checkbox"/> Other: <u>PTOL-324</u> . |

DETAILED ACTION

Drawings

The Examiner objects to the amended drawings received on 11/24/2003. Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings, which shall be an attachment to the amendment document and, in the header, labeled "Replacement Sheet." Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. All changes to the drawing(s) shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper. (See MPEP 714 (d)). Appropriate correction is required.

Specification

The disclosure is objected to because of the following informalities:

- a.** Page 10 line 13 the word "more" or the like is missing between the phrases "by use of " and "than one protocol". Appropriate correction is required.
- b.** The "BRIEF SUMMARY OF THE INVENTION" section should contain brief description of the disclosed subject matter rather repetitive claimed language of the claims.

Claim Objections

Claim 12 - 15 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In regards to claims 12-13 the claims recite "the system". There is no recitation of "the system" within the independent claim for which these

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claim depend. In regards to claim 15, the claim recites "the method" however there is no recitation of "the method" within the independent claim which this claim depends.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- a. Claims 3,8, and 13 recite the limitation "the client" in line 1. There is insufficient antecedent basis for this limitation in the claim.
- b. Claim 14-15 recites the limitation "wherein means for displaying the transcoded digital object" in lines. 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 6, 9, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaffer et al. (US 6,092,114).

In regards to claim 1, Shaffer et al. discloses a method of email administration comprising the steps of:

- receiving through a transcoding gateway(fig. 1-#12, #26) an email message(col. 4 ll. 1-4, col. 6 ll. 7-10), wherein
 - the email message comprises at least one digital object (col. 5 ll. 61-64, col. 6 ll. 1-3) having a digital object type (i.e. file extension, col. 6 ll. 22-23);

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- the transcoding gateway(fig. 1-#12; #26) is coupled to one or more display devices(fig. 1-#14, #16, #18, col. 4 ll. 27-37) and
- the transcoding gateway(fig. 1-#12, #26) comprises, for each display device, a display device record (fig. 1 - #34, col. 2 ll. 45-54 i.e. lookup table, col. 3 ll. 1-4) comprising display format attributes (col. 2 ll. 54-59) of each display device, wherein the display format attributes include a display format type (col. 7 ll. 48-52) for each display device (col. 6 ll. 33-39);
- finding a display device record (fig. 1 - #34, col. 2 ll. 45-54 i.e. lookup table, col. 3 ll. 1-4) for a destination display device(fig. 1-#14, #16, #18, col. 4 ll. 27-37, col. 6 ll. 15-18), wherein the destination display device comprises a display device having a display format type that is the same as the digital object type(col. 6 ll. 33-52);
- transcoding the digital object in dependence upon the display format attributes of the destination display device(col. 7 ll. 3-5); and
- displaying (col. 8 ll. 13-14) the transcoded digital object on the destination display device (col. 7 ll. 53-57).

In regards to claim 4,9 and 14, Shaffer et al. discloses

- wherein displaying the transcoded digital object on the destination display device further comprises writing the transcoded digital object to display memory(col. 6 ll. 7-9)

In regards to claim 6, Shaffer et al. discloses a system for email administration (fig. 1-10) comprising:

- means receiving through a transcoding gateway(fig. 1-#12, #26) an email message(col. 4 ll. 1-4, col. 6 ll. 7-10), wherein
 - the email message comprises at least one digital object (col. 5 ll. 61-64, col. 6 ll. 1-3) having a digital object type (i.e. file extension, col. 6 ll. 22-23);

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- the transcoding gateway(fig. 1-#12, #26) is coupled to one or more display devices(fig. 1-#14, #16, #18, col. 4 ll. 27-37) and
- the transcoding gateway(fig. 1-#12, #26) comprises, for each display device, a display device record (fig. 1 - #34, col. 2 ll. 45-54 i.e. lookup table, col. 3 ll. 1-4) comprising display format attributes(col. 2 ll. 54-59) of each display device, wherein the display format attributes include a display format type (col. 7 ll. 48-52) for each display device (col. 6 ll. 33-39);
- means for finding a display device record (fig. 1 - #34, col. 2 ll. 45-54 i.e. lookup table, col. 3 ll. 1-4) for a destination display device(fig. 1-#14, #16, #18, col. 4 ll. 27-37, col. 6 ll. 15-18), wherein the destination display device comprises a display device having a display format type that is the same as the digital object type(col. 6 ll. 33-52);
- means for transcoding the digital object in dependence upon the display format attributes of the destination display device(col. 7 ll. 3-5); and
- means for displaying (col. 8 ll. 13-14) the transcoded digital object on the destination display device (col. 7 ll. 53-57).

In regards to claim 11, Shaffer et al. discloses a computer program product for email administration comprising:

- a recording medium(i.e. memory col. 6 ll. 42-45);
- means, recorded on the recording medium, for receiving through a transcoding gateway(fig. 1-#12, #26) an email message(col. 4 ll. 1-4, col. 6 ll. 7-10), wherein
 - the email message comprises at least one digital object (col. 5 ll. 61-64, col. 6 ll. 1-3) having a digital object type (i.e. file extension, col. 6 ll. 22-23);

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- the transcoding gateway(fig. 1-#12, #26) is coupled to one or more display devices(fig. 1-#14, #16, #18, col. 4 ll. 27-37), and
- the transcoding gateway(fig. 1-#12, #26) comprises, for each display device, a display device record (fig. 1 - #34, col. 2 ll. 45-54 i.e. lookup table, col. 3 ll. 1-4) comprising display format attributes (col. 2 ll. 54-59) of each display device, wherein the display format attributes include a display format type (col. 7 ll. 48-52) for each display device (col. 6 ll. 33-39);
- means, recorded on the recording medium (i.e. register col. 2 ll. 47-49), finding a display device record (fig. 1 - #34, col. 2 ll. 45-54 i.e. lookup table, col. 3 ll. 1-4) for a destination display device(fig. 1-#14, #16, #18, col. 4 ll. 27-37, col. 6 ll. 15-18), wherein the destination display device comprises a display device having a display format type that is the same as the digital object type(col. 6 ll. 33-52);
- means, recorded on the recording medium (i.e. conversion program stored in memory, col. 7 ll. 13-22), for transcoding the digital object in dependence upon the display format attributes of the destination display device(col. 7 ll. 3-5); and
- means, recorded on the recording medium, for displaying (col. 8 ll. 13-14) the transcoded digital object on the destination display device (col. 7 ll. 53-57).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 2,3, 5-8,10,12,13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. (US 6,092,114) in view of Tsai (US 6,839,741).

In regards to claim 2,7 and 12 Shaffer et al. discloses wherein the Transcoding gateway (fig. 17-#12-15,#25) comprises an email recipient (col. 4 ll. 4-11),
Shaffer et al. is silent on:

- wherein the Transcoding gateway also comprises an email client, a web browser, and a HTTP Server

Tsai teaches:

A transcoding gateway (fig. 90-#12,90) comprising an email client(fig 4-#86), a web browser(fig. 4-# 84,col. 6 ll. 4-9) and an HTTP Server(col. 6 ll. 45-57).

It would be obvious to one of ordinary skill in the art at the time of the invention to modify Shaffer et al. by having a transcoding gateway which comprises an email client, web browser and HTTP Server, as taught by TSAI in order to facilitate the presentation of email attachments on local email clients and web-based email clients received by a recipient ((col. 2 ll. 1 ll. 6-9, col. 2 ll. 7-13))

In regards to claim 3,8 and 13 Schaffer et al. wherein the client device (fig. 10) comprises

- a display device(fig. 1-#14, #16, #18, col. 4 ll. 27-37) and
- a microcomputer(fig 12-16, 30-34),
 - wherein the microcomputer further comprises the transcoding gateway (fig. 1-#12),

Schaffer et al. is silent on a microcomputer

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- wherein the microcomputer further comprises an email client, a web browser wherein the transcoding gateway (fig. 1-#12), is coupled(fig 1) for data communications.

Tsai discloses a microcomputer

- wherein the microcomputer further comprises an email client (fig 4-#86), transcoding gateway (fig 5-#90), a web browser(fig. 4-# 84,col. 6 ll. 4-9), and an HTTP server(col. 6 ll. 45-57), wherein the transcoding gateway fig 5-#90), the email client(fig 4-#86 fig 5-#12), the web browser(fig. 4-# 84,col. 6 ll. 4-9, fig 5-#12, and the HTTP server (col. 6 ll. 45-57) are coupled(fig 5,) for data communications.

It would be obvious to one of ordinary skill in the art at the time of the invention to modify Shaffer et al. by having a transcoding gateway, email client, web browser and HTTP server coupled for communication in order to facilitate the presentation of email attachments on local email clients and web-based email clients received by a recipient (col. 2 ll. 1 ll. 6-9, col. 2 ll. 7-13)

In regards to claim 5,10 and 15, Shaffer et al. discloses displaying the transcoded digital object(col. 8 ll. 13-14) on the destination display device (fig 1-14-18)

Shaffer et al. does not disclose:

- wherein displaying the transcoded digital object on the destination display device further comprises sending the transcoded digital object to a browser.

Tsai discloses

- wherein displaying the transcoded digital object (col. 6 ll. 53-57) on the destination display device (fig 5-14A-C) further comprises sending the transcoded digital object (fig 5. #26) to a browser (fig 4-84, col. 5 ll. 25-30,38-42).

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It would be obvious to one of ordinary skill in the art at the time of the invention to modify Schaffer by having a transcoded digital object sent to a browser as taught by Tsai in order to allow a recipient to view an email attachment convert to HTML format in a web browser (col. 5 ll. 25-30,38-42, col. 6 ll. 34-40).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

- McMillan; David G. (US 6789108) Method and apparatus for dissemination of rich media
- Chang; Darwin et al. (US 6598076) Method and apparatus for electronically communicating an electronic message having an electronic attachment
- Schuetze; Robert Charles et al. (US 6101320) Electronic mail communication system and method
- McPhederan, P S G et al. (US 6101320) Electronic mail communicating system has routing unit which determines recipient's form and routes electronic mail through gateway to exchanger which receives and sends mail in recipient's format
- Jones; Mark Alan (US 5832221) Universal message storage system
- Jimenez, Ray et al. (US 20010048676) Methods and apparatus for executing an audio attachment using an audio web retrieval telephone system


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn F. Fleary whose telephone number is (571) 572-7218. The examiner can normally be reached on 8:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Carolyn F Fleary
Examiner
Art Unit 2152


GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

10/046,951

Examiner

Carolyn F. Fleary

Applicant(s)

BODIN ET AL.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 11/24/2003 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
 - ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☐ 2. Abstract:
 - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☒ 3. Amendments to the drawings:
 - ☒ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☐ 4. Amendments to the claims:
 - ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☐ E. Other: _____.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted within the time period set forth in the final Office action.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.